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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,086	01/25/2002	Bret H. Ashton	T6898	1431
25943	7590	05/05/2004	EXAMINER	
SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITES 1600-1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204			LEE, JONG SUK	
		ART UNIT	PAPER NUMBER	
		3673		

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/057,086	ASHTON ET AL.
	Examiner Jong-Suk (James) Lee	Art Unit 3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 26 February 2004.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-25,27 and 42-68 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-25,27-40,42-68 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. The amendment filed February 26, 2004 has been entered. It is noted that the application serial no. in the amendment letter is mistakenly presented as 10/057,068 and it is corrected to 10/057,086.
  
2. Upon further consideration, allowable subject matter indicated in the previous office action mailed on August 22, 2003 have been withdrawn in view of the reference to Fawley (US 2002/0095905). Therefore, the new ground of rejection based on the abovementioned reference is as follows.

With respect to the applicant's argument that applicant explicitly reserves the right to challenge Fawley's eligibility as a prior art reference, it is advised that for reference publication and patents of patent applications filed under 35 U.S.C. § 111 (a) with no claim for the benefit of, or priority to, a prior application, the prior art dates under §102 (e) accorded to these references are the earliest effective United States filing date, thus, a publication and patent of a 111(a) application, which does not claim any benefit under either 35 U.S.C. §119 (e), 120 or 365 (c), would be accorded the application's actual filing date as its prior art date under §102 (e).

Therefore, Fawley's reference is considered to be a proper prior art reference to applicant's claimed invention.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 8, 10, 14-18, 21-23, 27, 29, 33, 36-39, 42, 44-50, 52, 54, 58, 59, 61, 65, 66 and 67 are rejected under 35 U.S.C. 102(e) as being anticipated by Fawley (US 2002/0095905 A1).

Fawley discloses a reinforced wood pole/support piling and inherent method for reinforcing a wood support piling comprising of: a non-hollow elongate shaft/wood pole (11, 20) having a length of at least 10 feet long as a electric pole and an exterior surface extending along the length, a composite wrapping (12), having a plurality of strips (26-28) of high strength filaments (48) being saturated with the resin before the strips are wrapped helically around the wood body (20) (see pg.4, paragraph no. 0034), encircling the exterior surface along at least a portion of the length and forming a layer of uniform thickness and materials and a single, seamless layer, wherein the composite wrapping applying a radial compressive force upon the elongate shaft by applying tensile strength component of the filaments to the wood body (20) in the circumferential direction (pg. 4, paragraph no. 0040) and being bonded to the elongate shaft with curable resins (see pg. 4, paragraph no. 0034) to increase the stiffness and/or reinforcement of the wood pole, the stuffiness/strength of the pole increases at least more than 40 % of the bare

pole strength (see pg.5, paragraph no. 0044-0048) (see Figs. 1-14; pg.3, paragraph nos. 0029-0032; pg.4, paragraph no. 0033-0040).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>®</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 7, 9, 11, 12, 19, 20, 24, 25, 30-32, 34, 35, 40, 51, 53, 55, 56, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawley in view of Owens et al (US 5,175,973). The teachings of Fawley have been discussed above.

However, Fawley fails to disclose or fairly suggest the composite wrapping covering a portion of the wood pole to be buried in the ground and a range of moisture content.

Owens et al discloses a compression repair method and apparatus for a wood pole comprising of a wood pole (4) having at least portion of the pole being wrapped around with a fiber glass blanket/mat (3), the wood pole having a moisture content of 19 % for the best condition of the wood piling/pole (see col.9, lines 60-68) and the portion of wrapped with the

blanket is partially buried in the ground as depicted in Fig. 1, the fiber glass blanket further comprising of a plurality/multiple-tow bundle of strands/fibers (5-7) running at an angle of 45 degrees to 90 degrees for each bundles (see Fig. 2) and a coating of a composite resin (9) (see Figs. 1-3; col.2, lines 39-49; col.4, lines 37-68; col.5, lines 41-58; col.6, lines 5-60; col.7, lines 46-55).

Therefore, in view of Owens et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to treat the moisture content for the wood pole of Fawley as taught by Owens et al. and to wrap around with the composite wrapping the buried portion of the pole in order to extend the protection and reinforcement for the pole to the buried portion.

7. Claims 13, 28, 43, 57, 64 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawley in view of Williams et al (US 5,516,236). The teachings of Fawley et al have been discussed above.

The teachings of Fawley fails to specifically disclose or fairly suggest a mechanical bond to the composite wrapping. Williams et al discloses a timber pile protection system comprising of a composite wrapping (2) bonded to the timber/wood pile (3) by means of a mechanical bond/straps (13) with nails (15) as depicted in Fig. 2 as discussed above.

Therefore, in view of Williams et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to include the straps with nails in order to enhance the reinforcement of the composite wrapping to the wood piling/pole.

8. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fawley in view of Owens et al, and further in view of Williams et al (US 5,516,236). The teachings of Fawley modified by Owens et al have been discussed above.

The teachings of Fawley modified by Owens et al fails to specifically disclose or fairly suggest a mechanical bond to the composite wrapping. Williams et al discloses a timber pile protection system comprising of a composite wrapping (2) bonded to the timber/wood pile (3) by means of a mechanical bond/straps (13) with nails (15) as depicted in Fig. 2 (see Figs. 1-3; col.3, lines 40-67; col.4, lines 1-56).

Therefore, in view of Williams et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to further modify the composite wrapping of Fawley, as modified by Owens et al, by including the straps with nails in order to enhance the reinforcement of the composite wrapping to the wood piling/pole.

#### *Response to Arguments*

9. Applicant's arguments with respect that the Fawley reference does not teach the composite wrapping applies a radial compressive force upon the pole/piling is not persuasive because the tensile strength component of the filament of the Fawley's strip/wrapping is almost entirely applied to the wood body in the circumferential direction when the strip is wound helically around the wood body as mentioned in paragraph no. 0040 of the Fawley's reference.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl  
April 30, 2004



**Jong-Suk (James) Lee  
Primary Examiner  
Art Unit 3673**